

tesa AG 698-WCG/HCL
6713-St-bb**REMARKS*****Summary of Amendments Made******35 U.S.C. 112, second paragraph rejections***

Although the applicants disagree with the examiner's assessment of the term "suitable" for claim 13, in the interest of closing prosecution, this term has been substituted with a term which is believed to encompass the intended scope of the applicants' invention. Regardless of what term is used, one of ordinary skill in the art would be able to determine that the claim limitation refers to the fact that the adhesive film has the property that it can be hot pressed at temperatures below 120°C.

It is believed that either term in claim 13 is proper and that the two separate requirement for claims under 35 U.S.C § 112, second paragraph are believed to have been met (see MPEP 2171); which are:

- (A) the claims must set forth the subject matter that applicants regard as their invention; and
- (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant;

Moreover, it has not been adequately explained why one of ordinary skill in the art would not be able to determine if the adhesive film had the claimed property.

It is presumed that the examiner is aware of the effects of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.* on patent prosecution, i.e. any amendment related to patentability can be viewed as prosecution history estoppel. In this environment, applicants' representative cannot in good faith cannot continue to modify the claims on behalf of their clients if there are no reasons of record to support the rejection. Even if the applicants were amenable to further modify the claim, they cannot afford to continue to guess at what the examiner would find to be permissible terminology. With this in mind, section 2173.02 of the MPEP is reproduced below:

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve clarity or precision of the language used, but should not reject claims or insist on their own preferences if

tasa AG 698-WCG/HCL
6713-St-bb

other modes of expression selected by applicants satisfy the statutory requirement. (see MPEP 2173.02)

If the above amendment is unacceptable to the examiner, it is requested that alternative terminology be presented in the next office action.

Claim 16 has been cancelled which renders this rejection moot (Applicants reserve the right to pursue this subject matter in a divisional application).

35 U.S.C. 103(a) rejections

Claims 9-14 and 16-20 were rejected as being obvious over Reylek et al. (EP 134 623) alone or in view of Tsukagoshi et al. (EP 140 619).

The arguments presented in the Appeal Brief of 18 December 2002 are considered to be repeated here. A few specific comments from the rejection are further addressed below:

"Initially the Examiner notes that the presence of holes in the adhesive layer, i.e. the "punched film section" in claim 14 is believed **well within the ordinary skill of one in the electrical laminate art** who may wish to punch holes in the adhesive layer for a variety of reasons related to various electrical related applications the resultant article may have." - page 3, lines 13-17

However, it is also well known that "well within the ordinary skill of one in the art" is an improper standard to apply when asserting a *prima facie* case of obviousness - see MPEP 2143.01 - "A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (BPAI 1993)."

"Finally, as to the relied prior art combination, the Examiner further believes that a person skilled in the art would know that he could use silver coated particles having diameters which exceed the adhesive layer thickness in order to improve electrical conductivity."

This statement is objected to on at least two grounds.

tesa AG 698-WCG/HCL
6713-St-bb

First, if this supposition is to be considered to be equivalent to the examiner taking official notice, the applicants hereby formally request that the examiner supply a reference to support this comment with the next communication as per MPEP 2144.03.

Second, the statement made above is based on hindsight reconstruction at worst or represents "could be modified"/"obvious to try"-type rationale at best. In either case, this is inappropriate for establishing motivation to combine the references cited. The statement made does not flow from the references either explicitly or implicitly.

It is noted that the ultimate determination whether an invention would have been obvious under 35 U.S.C. § 103 is a legal conclusion based on underlying findings of fact (see *In re Kotzab*, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000)). If the rationale is implicit, it is further noted that while motivation may be implicit from the prior art as a whole, rather than expressly stated in the references when the USPTO relies on an express or an implicit show of motivation, it must provide particular findings related to its conclusions, and the showing must be clear and particular. Broad conclusionary statements standing alone are not "evidence". see *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Claims 9-20 were rejected as being obvious over Engeldinger et al. (EP 846 743 - English abstract) in view of Reylek et al., *supra*.

The applicants' response from 26 July 2002 is to be considered repeated here as there is no further insight as to why the examiner now believes that "...the method of implanting electrical modules in a card body as set forth in claim 15 is believed clearly disclosed by the relied prior art combination." At the very least the previous withdrawal of this rejection would appear to be *prima facie* evidence that the combination of references would not be clear to one of ordinary skill in the art. Given this prosecution history and without further explanation, why would one of ordinary skill in the art believe that the invention is clearly disclosed? or that there is a clear teaching or suggestion to combine the references? or that the combination of references does not constitute hindsight reconstruction?

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (9 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 31 July 2003

By: Jennifer Archer
Jennifer Archer